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10/687,052	10/17/2003	Travis M. Mulford		7521

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EXAMINER

KWIECINSKI, RYAN D

ART UNIT	PAPER NUMBER
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3635

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/687,052

Applicant(s)

MULFORD ET AL.

Examiner

Ryan D. Kwiecinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/27/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 9, 10 and 12-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/17/2003
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

The response to the requirement for restriction received October 27th, 2006 has been received and considered. Applicant elects Species I stating that Claims 1-11 and 15-16 are drawn to Species I. The applicant traverses the requirement for restriction but does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Although Applicant states that Claims 9-10 and 15-16 are drawn to Species I, Species I does not show a plate positioning box or a rectangular box. The plate positioning box (30) is shown in Figure 2, Species II. Also the "interior reflective surface" is disclosed on page 13, line 13 of the specification, referring to Fig. 2, Species II.

Claims 9-10 and 15-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species II, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 27th 2006.

Claims 1-8 and 11 have been examined in this Office Action.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plate positioning segment and the seal of claim 1, the insulating wrap of claim 3, and a perimeter gasket

system of claim 5 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities:

Page 6, line 3: It appears "removable" should be –removably—

Page 6, lines 6-8: "plates over...channeling system entry". Improper sentence structure and/or sentence wording.

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Page 6, line 8: It appears "It may includes" should be --It may include--

Page 12, line 5: It appears "seals" should be --seal--

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities:

Claim 1, lines 5 and 18: "by plate" appears it should be --by a plate--.

Claim 1, line 6: "removable" appears it should be --removably--.

Claim 1 recites the limitation "the ceiling" per lines 2 and 7 and "the roof" per lines 4, and 19. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,918,216 B2 to Hoy et al.

Claim 1:

Hoy et al. teaches a skylight conversion kit for a light channeling system with a plate positioning segment proximate the ceiling (92, Fig.2) having an open exterior roof end and an open interior ceiling end such as the duct work of a removed evaporative cooler extending between the roof and its room interior comprising:

- a. a ceiling mount (90, Fig.2) with an opening defined by plate support structure (91, Fig.2) adapted to removably secure over the open interior end of the light channeling system plate positioning segment (80, Fig.2) proximate the ceiling to provide an open light channel between the roof and ceiling openings, said ceiling mount plate support structure adapted to removably hold over the ceiling mount opening and allow the lifting and turning on edge of
- b. one or more insulated stackable decorative plates (88, Fig.2) sized and shaped to cover the ceiling mount opening when mounted on the plate support structure for addition or removal along a diagonal of the ceiling mount opening (the plates of Hoy's assembly are capable of being arranged as previous mentioned since the plates are a square shape surrounded by a square mounting plate), whereby the plates are stacked on the ceiling mount plate support structure (91, Fig.2) in a manner which transmits light there through into the interior of a room, and the number of

plates is selected and added to provide the desired decorative and insulating properties,

- c. a roof mount (20, Fig.2) with an opening defined by plate securing structure (23, Fig.2) adapted to secure to the roof with its opening positioned over the exterior open roof end of the light channeling system (end by 64, Fig.2), and seal thereto on the plate securing structure (54, Fig.2)
- d. at least one insulated light transmitting plate (37, Fig.2) sized to cover and seal the roof mount opening (Column 2, lines 41-56) to allow exterior light to enter and pass through the light channeling system, while insulating the exterior end of the light channeling system opening and preventing heat transfer and the entrance of moisture, bugs, and dust (54, Fig.2).

Claim 2:

Hoy et al. teaches a skylight conversion kit according to Claim 1, including a decorative trim finish associated with the ceiling mount (underside of 90, Fig.2) to hide any evidence of the light channeling system ceiling mount is secured in position proximate the ceiling.

Claim 4:

Hoy et al. teaches a skylight conversion kit according to Claim 1, wherein the insulated light transmitting plate covering the exterior end of the light channeling system is flat to minimize roof obstruction and wind noise (37, Fig.2).

Claim 6:

Hoy et al. teaches a skylight conversion kit according to claim 4, wherein the decorative plates are patterned and colored to suit the preference of the user (Column 1, lines 54-57). The plates may be diffuser panels or lenses. The preference of the user is not structurally patentable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,918,216 B2 to Hoy et al. in view of US 2003/0000158 A1 to Borges.

Claim 3:

Hoy et al. teaches a skylight conversion kit according to Claim 1, but does not teach including an insulating wrap adapted to secure about the exterior of the light channeling system and provide the desired insulation. Borges teaches including an insulating wrap adapted to secure about the exterior of the light channeling system and provide the desired insulation (24, 24', Fig.2 and 3 respectively). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an insulating wrap about the exterior of the light channeling system in order to provide insulation of the tubing

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to keep the temperatures of the air from changing the temperatures within the building. Using insulation is notoriously well known in the art.

Claim 8:

Hoy et al. teaches a skylight conversion kit according to Claim 1, wherein the plate positioning segment is a rectangular tube (80, Fig.2) with a square cross-section (80,84, Fig.2), and the ceiling mount opening (90, Fig.2) and decorative plates (88, Fig.2) are square shaped so that the decorative plates may be lifted and turned on edge within the plate positioning segment for addition or removal through the diagonal opening of the ceiling mount. Hoy et al. does not teach wherein the light channeling system is a rectangular tube with a square cross-section. Borges teaches wherein the light channeling tube is a rectangular tube with a square cross-section. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed Hoy's skylight assembly with a rectangular tube with a square cross-section. Using rectangular tubes in skylight assemblies would eliminate the need for an adapter box to be used to connect the rectangular tube to the rectangular mounting plates, therefore reducing the amount of parts as well as cost.

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,918,216 B2 to Hoy et al. in view of US 5,103,603 to Verby et al.

Claim 5:

Hoy et al. teaches a skylight conversion kit according to Claim 1, but does not teach including a perimeter gasket system placed between and along the perimeter edges of a plurality of insulated stacked decorative plates to isolate them and absorb vibration to prevent accidental contact and vibration damage. Verby et al. teaches a perimeter gasket system (52,54,56, Fig.2) placed between and along the perimeter edges of a plurality of insulated stacked decorative plates (16, Fig.2) to isolate them and absorb vibration to prevent accidental contact and vibration damage. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a gasket system in Hoy's skylight system in order to prevent the plates from coming in contact with one another as well as other parts of the skylight system.

Claim 11:

Hoy et al. teaches a skylight conversion kit according to Claim 1, but does not teach wherein the roof mount is adapted to tilt open the light transmitting plate on the roof in an open mode to allow air to pass through the light channeling system and into the interior of the room when the decorative plates are removed, and to close in a closed mode to seal the light channeling system when the decorative plates are in place to provide an insulated skylight.

Verby et al. teaches the roof mount is adapted to tilt open the light transmitting plate (74,84,86, Fig.2) on the roof in an open mode to allow air to pass through the light channeling system and into the interior of the room when the decorative plates are removed, and to close in a closed mode to seal the light

channeling system when the decorative plates are in place to provide an insulated skylight.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have hingedly connected the upper plate to the roof mount in order to allow the skylight to open to allow air to circulate through the house. It would also be paramount in allowing air to circulate through the light channeling system to remove unwanted condensation.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,918,216 B2 to Hoy et al. in view of US 5,103,603 to Verby et al. in view of US 2004/0040228 A1 to Emde et al.

Claim 7:

Hoy et al. and Verby et al. teach a skylight conversion kit according to Claim 5, but do not teach wherein each decorative plate has different insulating properties and is employed in multiples to provide the desired insulating factor. Emde et al. teaches wherein each decorative plate has different insulating properties and is employed in multiples to provide the desired insulating factor (Page 2, Para.21, Lines 1-6; Page 3, Para.36, lines 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included decorative plates made from different materials in Hoy's skylight conversion kit. Decorative plates constructed from different materials will have

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different insulating properties, which would allow the user to use the plates in different combinations to create different insulating factors in the skylight assembly.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan D. Kwiecinski whose telephone number is (571)272-5160. The examiner can normally be reached on Monday - Friday from 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (571)272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


RDK


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